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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/712,302	11/14/2000	Christopher J. Smith	046700-5044	8621

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EXAMINER

KARMIS, STEFANOS

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/712,302	SMITH, CHRISTOPHER J.	
	Examiner	Art Unit	
	Stefano Karmis	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to Applicant's amendment filed 13 September 2004.

Status of Claims

2. Claims 1-30 are left as originally filed and are pending in this application.

Summary of this Office Action

3. Applicant's arguments, filed 13 September 2004, with respect to the rejection(s) of claim(s) 1-30 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made as discussed below.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 15 and 30 recite the limitation "said second bidder." There is insufficient antecedent basis for this limitation in the claim.

Specifically claim 1 never recites that there is a second bidder performing the first bid or the second bid.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-3, 5-11, 13-18, 20-26 and 28-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Chaves U.S. Publication 2001/0044769.

Regarding independent claims 1 and 16, Chaves discloses a method to transform bids in an electronic auction comprising: receiving a first bid having a first value and a first unit of measurement, and second bid having a second value and a second unit of measurement (page 3, paragraph 0057); and transforming said first and second values to third and forth values, respectively, having a standard unit of measurement (page 3, paragraphs 0062-0086).

Claims 2 and 17, the first value is a monthly lease payment and said second value is a purchase price (page 3, paragraphs 0062-0086).

Claims 3 and 18, determining a first transformation factor for said first value; determining a second transformation factor for said second value; and transforming said first value using said first transformation and said second value using said second transformation factor (page 3, paragraphs 0062-0086).

Claims 5 and 20, transforming said first value and said second value comprises multiplying said first value by said first transformation factor and said second value by said second transformation factor (page 3, paragraphs 0062-0086).

Claims 6 and 21, searching a look-up table for said first and second transformation factors; and retrieving said first and second transformation factors in accordance with said search (page 3, paragraphs 0062-0086).

Claims 7 and 22, identifying a first set of transformation variables for said first value; determining a first transformation function to derive said standard unit of measurement using said first value and said first set of transformation variables; receiving a value for each of said first set of transformation variables; and determining said first transformation factor using received values and said first transformation function (page 3, paragraphs 0062-0086).

Claims 8 and 23, the first set of transformation variables comprise at least one of a group comprising tax rate, a depreciation model, a book value life, a cost of debt, a cost of capital, risk factors based on different leasing plans, inception costs and exit costs (page 3, paragraph 0057).

Claims 9 and 24, identifying a second set of transformation variables for said first value; determining a second transformation function to derive said standard unit of measurement using said second value and said second set of transformation variables; receiving a value for each of said second set of transformation variables; and determining said second transformation factor using received values and said second transformation function (page 3, paragraphs 0062-0086).

Claims 10 and 25, the second set of transformation variables comprise at least one of a group comprising tax rate, a depreciation model, a book value life, a cost of debt, a cost of capital, risk factors based on different leasing plans, inception costs and exit costs (page 3, paragraph 0057).

Claims 11 and 26, the standard unit of measurement is a buyer comparative bid parameter (page 3, paragraph 0057).

Claims 13 and 28, comparing said third value and said fourth value; and ranking said third value with respect to said fourth value in accordance with said comparison (page 4, paragraphs 0118-0119).

Claims 14 and 29, displaying said ranking for a buyer (page 4, paragraphs 0118-0119).

Claims 15 and 30, detransforming said third value to a fifth value having said second unit of measurement, and said fourth value to a sixth value having said first unit of measurement; and sending said fifth value to said second bidder and said sixth value to said first bidder (page 4, paragraphs 0099-0125).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 4, 12, 19 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chaves U.S. Publication 2001/0044769.

Claims 4 and 19, Chaves teaches transforming said first value and said second value (page 3, paragraphs 0062-0086). Chaves fails to specify that the transformation require a linear transformation. Official Notice is taken that linear transformation are old and well known in the art. Therefore it would've been obvious to one of ordinary skill at the time of the Applicant's invention to modify the teachings of Chaves and include linear transformations because it is an efficient manner to transfer a value in a certain unit into another desired unit for easier reference for a buyer or seller.

Claims 12 and 27, Chaves teaches transforming said first value and said second value (page 3, paragraphs 0062-0086). Chaves fails to teach a bid parameter such as net present value. Official Notice is taken that net present value, as a parameter in transaction is old and well known in the art. Therefore it would've been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Chaves and include net present value because it provides an efficient manner to relate the actual cost of item when determining a justifiable asking price.

Response to Arguments

12. Applicant's arguments with respect to claim 1-30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (703) 305-8130. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully Submitted
Stefano Karmis
21 December 2004


HANI M. KAZIMI
PRIMARY EXAMINER